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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,455	03/31/2004	Alexander Rzesnitzek	BE-125	6407

7590 09/08/2006

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EXAMINER

ASTORINO, MICHAEL C

ART UNIT PAPER NUMBER

3736

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/815,455	<b>Applicant(s)</b> RZESNITZEK ET AL.	
	<b>Examiner</b> Michael C. Astorino	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

### **DETAILED ACTION**

The Examiner acknowledges the amendment filed August 18, 2006.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Echerer US Patent Number 5,801,755 A.

The amended claims have not overcome the rejection of Echerer. See the response to arguments section below for details. See also previous office action(s) for details of rejections.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer US Patent Number 5,801,755 A as applied to claim 1 above, and further in view of Reber et al. US Patent Number 5,950,632.

See previous office action for details of the rejection.

***Response to Arguments***

Applicant's arguments filed August 18, 2006 have been fully considered but they are not persuasive.

The applicant has asserted two arguments in combination with the amendment to overcome the prior art rejection. The examiner disagrees with the Applicant's assertions.

First, the applicant states that, "Applicant has amended claim 1 to recite that the sequence of video motion pictures of the patient which is shorter than the time intervals." However, this amendment has not been recited in the claims. Hence, Applicant's assertions regarding this absent limitation in the claims are moot.

Second, Applicant's argues that:

Furthermore, Echerer does not disclose a system having devices for automatic patient identification, as in the presently claimed invention. Echerer does not disclose that the identification device, after identification, automatically activates a video camera that records a patient in a marked object field who is performing prescribed movements, over a prescribed period of time."

The examiner believes Echerer teaches the system as presently claimed. In regards to the Applicant statement above, it is the Examiner's belief that the Applicant is referring to the newly added claim limitation, "...devices for automatically identifying the patients, whereby the

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identifying devices are operative to automatically activate the camera to record the patient concerned, after identification, while the patient carries out predefined movements in the object field..." (Italics added). The Applicant argued assertions are not supported by the amendment.

First of all, the amendment introduces words to the claim that is stylistically awkward. Only after reading the claim numerous times does an understanding of the language make sense. It appears the Applicant is attempting to insert method steps into the apparatus claim, although Applicant falls a bit shy of doing so. That said, the claim is directed to an apparatus claim and requires the examiner to meet the structural limitations of the claimed invention.

Secondly, the newly added "devices" are claimed via intended use via the word "for." As stated in previous office action, the word "for" is properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. Additionally, the phrase "operative to" is intended use and as such, does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. It is the examiner's position that Echerer is capable of performing the intended use. Echerer teaches the use of a still frame image from the video image. After the still frame image is created, the use of the video camera returns, and is thus activated after the identification step. Thus Echerer rejects the claimed invention.

Third, the applicant asserts in his arguments that certain limitations are in the claim when they are not. First the limitation is not affirmatively claimed because of the intended use recited in the claim. Although intended use language requires that the art be inherently capable of performing the use, it is, as discussed above, the Examiner sincere belief that Echerer meets the

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metes and bounds of the claimed language. Also, the applicant argues that Echerer fails to teach “performing prescribed movements” however the claim as recited only requires predefined movements. Echerer’s system meets that limitation because a patient will perform movements in front of the camera so that the patient can be examined by a remote doctor, see examples 1-4 in column 6.

**Note to Applicant:** It is the examiner’s position that applied prior art reference, Echerer, can be overcome by Applicant by amending the claim. The Applicant is invited to request and interview to discuss language that would overcome the applied prior art reference(s).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Astorino whose telephone number is 571-272-4723.

The examiner can normally be reached on Monday-Friday, 8:30AM to 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Astorino  
September 4, 2006

  
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